

REMARKS

This communication is filed in response to the Office Action mailed on May 19, 2006. No claims are amended, claims 1-7, 12-18, 47, and 49-64 are canceled, and no claims have been added. As a result, claims 8-11, 19-46, 48, and 65 remain pending in this Application, of which claims 8-11, 19, 21-46, 48, and 65 are withdrawn.

Claims 28-30, 34-38, 43-46, 48, and 65 Withdrawn

It is noted that claims 28-30, 34-38, 43-46, 48, and 65 have been withdrawn because the Office asserts that the limitation “complementary shape” would not read on FIG. 15 of the Application; but only on FIG. 5. This requirement has been made final. However, it is respectfully noted as a matter of record that there is no reason that claims which read on FIG. 5 cannot also read on FIG. 15. For example, the “plurality of widths” shown in FIG. 15 may exist, or not, in combination, with the complementary shapes shown in FIG. 5. Thus, the withdrawn claims are not directed to non-elected subject matter.

While “Figure 15 is a top, plan view” according to the Application, pg. 7, line 20, it is respectfully noted that “Figures 4-10 can be alternatively be considered as side, cut-away views of the invention (using the “Z” direction to define a vertical dimension, or depth, which is substantially perpendicular to the horizontal X-Y plane in which the circuit board lays).” Application, pg. 15, lines 22-28. For example, the reader of the Application will notice that the language of non-withdrawn claim 20 tracks the language describing FIG. 15 rather closely. Thus, it is entirely possible to construct a physical object having a side, cut-away view according to FIG. 5, and a top, plan view according to FIG. 15. Therefore, claims withdrawn by the Office that read on FIG. 5 may also read on FIG. 15, and vice-versa.

§102 Rejection of the Claims

Claim 20 was rejected under 35 USC § 102(b) as being anticipated by Kumagai et al. (U.S. Patent No. 6,147,573, hereinafter “Kumagai”). First, the Applicant does not admit that Kumagai is prior art, and reserves the right to swear behind this reference in the future. Second, because the Office has not properly established a *prima facie* case of anticipation, the Applicant respectfully traverses this rejection.

Kumagai teaches a multilayer electronic body 24 to be mounted to a printed circuit board 9. *See* Kumagai, FIG. 1D and Col. 4, lines 5-7. The body 24 is made from coil conductors 2 formed on green sheets 1 and connected to each other using through-holes 3 to form a coil 40. *See* Kumagai, FIGs. 1A, 1C; and Col. 4, lines 13-21, and 52-55. In FIG. 3B, cited by the Office, terminal electrodes 20 are connected to each end of the coil 40 with leading conductors 29. *See* Kumagai at FIGs. 1C and 3B; Col. 4, lines 52-55; and Col. 6, lines 26-34. In FIG. 3C, cited by the Office, Kumagai teaches forming a capacitor 28 connected to the coil 40 using a leading conductor 29. *See* Kumagai, Col. 7, line 64 – Col. 8, line 1.

It is asserted in the Office Action that Kumagai's leading conductors 29 (see FIGs. 3B and 3C) are the same as the interstices 150, 160 (See Application, FIG. 4A) claimed by the Applicant in claim 20. However, reading the cited portions of Kumagai reveals that such is not the case.

First, it is respectfully noted that independent claim 20 includes the following limitation: "a second conductive layer including a second interstice engaged with the first interstice". Thus, the first and second interstices are *engaged* (see Application, Figure 4A, elements 150, 160). To be "engaged" means "meshed," which in turn, means "interlocked." *See Webster's Ninth New Collegiate Dictionary*, G. & C. Merriam Company, pgs. 412 and 744, 1983. In other words, if one were to attempt to "pull" the conductive layers 110, 120 apart in the $\pm X$ direction in Application FIG. 16, for example, the engaged interstices 150, 160 would prevent such separation. However, this cannot be said about the conductors 29 of Kumagai. These conductors 29, which simply serve to connect each end of the coil 40 with respective electrodes 20, are not engaged in any sense of the word. *See* Kumagai, Col. 4, lines 50-55, and FIGs. 3B, 3C.

Second, the body 24 and conductors 29 do not provide "a first conductive layer including a first interstice, wherein the first interstice has a plurality of widths laying in a first plane ... a second conductive layer including a second interstice ... wherein the second interstice has a single second width laying in a second plane ... and a dielectric layer disposed between the first and second interstices to form a capacitor, wherein the first and second planes are substantially parallel, and wherein the second width substantially overlaps at least two of the plurality of widths" as claimed by the Applicant, and alleged in the Office Action. While an embodiment

having this type of construction is described in the Application at pg. 18, line 19 – pg. 19, line 29 (and shown in FIGs. 15 and 16), there is no evidence that such is provided anywhere within the bounds of Kumagai. Essentially, it is impossible for the conductors 29 to have any kind of “plurality of widths” as claimed by the Applicant.

It is respectfully noted that anticipation under 35 USC § 102 requires the disclosure in a single prior art reference of each element of the claim under consideration. *See Verdegall Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). “The *identical invention* must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131 (emphasis added).

Third, while claims during examination should be interpreted as broadly as their terms reasonably allow, that interpretation must be tempered by the context in which the terms are used. The *Hyatt* court states that “during examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.” *In re Hyatt*, 211 F.3d 1367, 1372, 54 U.S.P.Q.2D (BNA) 1664, 1667 (Fed. Cir. 2000) (emphasis added) (“During examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.”; citing *In re Graves*, 69 F.3d 1147, 1152, 36 U.S.P.Q.2D (BNA) 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 U.S.P.Q. (BNA) 1, 5 (Fed. Cir. 1985) (en banc).).

The interpretation of the term “interstice” and “plurality of first widths” proffered by the Office is neither reasonable, nor consistent with the specification. It is not reasonable because it does not encompass the meaning of the terms as understood by those of ordinary skill in the art, and confirmed by a standard dictionary, above. It is not consistent with the specification because it is apparent from viewing FIGs. 15 and 16 of the Application that the claimed relationship between the Applicant’s layers 110, 120; interstices 150, 160; and widths W5, W6 are not

anything like what is asserted by the Office with respect to Kumagai. *See* Application, pg. 18, line 19 – pg. 19, line 29; *see also* Application, pg. 9, lines 5-18 and FIG. 4A. For example, while the Applicant claims “a dielectric layer disposed between the first and second interstices to form a capacitor,” this type of function is impossible with the structure of Kumagai – placing a dielectric between the conductors 29 of Kumagai does not result in forming a capacitor. Rather, Kumagai provides a capacitor 28 using additional structure: by forming separate electrodes 33 on each side of a dielectric body 27. *See* Kumagai, Col. 7, line 64-Col. 8, line 4. Thus, characterizing Kumagai’s conductors 29 as “interstices” that can be engaged or used to form a capacitor, or asserting that these conductors 29 have a “plurality of widths laying in a first plane” (as shown in FIG. 15 of the Application) is beyond that which should be reasonably permitted during examination.

Since Kumagai does not teach the existence of engaged interstices, nor interstices that have a plurality of widths, what is disclosed by Kumagai is not identical to the subject matter of the embodiment claimed, and thus, the rejection of claim 20 under § 102 is improper. Reconsideration and allowance are respectfully requested.

CONCLUSION

The Applicant respectfully submits that all of the pending claims are in condition for allowance and notification to that effect is earnestly requested. **As noted above, if the Examiner is not convinced that all of the pending claims are in condition for allowance after reviewing this document, the courtesy of an Examiner’s Interview is respectfully requested prior to preparing and mailing any Final Office Action.**

The Examiner is invited to telephone the Applicant’s attorney Mark Muller at (210) 308-5677 to facilitate prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 18 day of July, 2006.

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